

Remarks/Arguments

Claims 24-46 were pending in the application. Claims 24-45 were rejected. Claim 46 is withdrawn. No new matter is presented. Applicants request reconsideration and a favorable decision in light of the below remarks.

Claim Rejections-35 U.S.C. §103

A. Claims 24-27, 29-42 and 44 are rejected under 35 U.S.C. §103(a) as being unpatentable over U.S. Pat. Publ. No. 2004/0223990 to Mondet et al. ("Mondet") as evidenced by Carbopol 1342 product specification sheet and Dow Corning 3225C Formulation Aid specification sheet. Applicants traverse the rejection.

Mondet's teaches a composition limited to "at least an effective amount of exfoliated phyllosilicates" (Mondet Abstract) and vast general teachings of hundreds of possible additional components. In order to arrive at the specific composition of the present invention as claimed, the Examiner's intended modification of Mondet to remove the exfoliated phyllosilicates would modify Mondet beyond its intended inventive use and inventive scope. Mondet would be rendered unsatisfactory for its intended purpose of the reduction of fillers in cosmetics. Mondet [0011]; [0012]; [0198]. In addition, Mondet teaches hundreds of components which can be combined to produce thousands of combinations. Thousands of combinations leads to no predictable expectation of success in the obvious development of the specific composition of the present application as claimed.

If proposed modification would render the prior art invention being modified unsatisfactory for its intended purpose, then there is no suggestion or motivation to make the proposed modification. *In re Gordon*, 733 F.2d 900, 221 USPQ 1125 (Fed. Cir. 1984). Through the use of exfoliated phyllosilicates,

Mondet achieves cosmetics with "good texture, hold, glossiness, mattness and absence of migration" because the exfoliated intercalated phyllosilicates take the place of fillers. Mondet [0014]; [0198]. Independent claim 24 of the current invention does not include Mondet's exfoliated phyllosilicate. In all embodiments, teachings and suggestions Mondet's publication includes "at least an effective amount of exfoliated phyllosilicates." Mondet also teaches that the exemplary phyllosilicates may be used in place of surfactants, emulsifying and co-emulsifying agents. *Id.* [0025]; [0026]. Mondet's exfoliated phyllosilicates are an essential component of the invention. In paragraph [0202] Mondet specifically states that "a person skilled in the art will take care to select ... compound(s) ... such that the advantageous properties of the composition according to the invention are not, or are not substantially, adversely affected by the envisaged addition." Therefore, the Examiners proposed modification of Mondet to remove the advantageous and inventive exfoliated phyllosilicate from the composition would render Mondet unsatisfactory for its intended purpose. As a result, there is no suggestion or motivation for a person of ordinary skill in the art to modify Mondet in order to create the composition of the current invention as claimed.

General guidance with no suggestion or motivation or teaching of a predictable solution is evidence of non obviousness. In re O'Farrell, 853 F.2d 894, 903-904 (Fed.Cir. 1988). Mondet teaches a specific composition "containing at least one fatty phase and at least an effective amount of exfoliated phyllosilicates." Mondet claim 1. In addition to these two components, Mondet teaches that the composition may also contain:

exfoliated phyllosilicates with intercalating agents of onium type and/or intercalating agents containing a polar group or of polymeric nature [0046]-[0075];

0.1% to 98% by weight of a fatty phase that may consist of

any C8-C16 volatile or any non-volatile oil which can then
comprise less than 10% by weight of water [0093]-[0117];
less than 70% by weight of an aqueous phase [0094];
less than 30% by weight of an amphoteric, anionic, cationic,
or non ionic emulsifying agent [0142]-[0158];
no emulsifying agent [0159];
0.1% to 60% by weight of film forming polymers that may
consist of liposoluble polymers or lipodispersible polymers
[0160]-[0188];
0.01% to 40% by weight of a particulate phase including
pigments and fillers [0190]-[0199]; and,
additional materials such as vitamins, preserving agents,
UV-screening agents etc.

Mondet merely provides general guidance as to additional
components within the composition. As presented above, Mondet
provides for the possible addition of hundreds of differing
compounds to the composition. These compounds create thousands
of differing composition combinations. For example, current
independent claim 24's component d) "a polar liquid in a
proportion of 0.1 to 5% with respect to the total weight of the
composition." The Examiner equates the "polar liquid" of the
current claim with Mondet's paragraph [0093] recitation that the
fatty phase can comprise less than 10% by weight water, less than
5% by weight water, less than 1% by weight water or no water at
all (anhydrous form fatty phase). Mondet's above water in fatty
phase limitation alone would lead a person of ordinary skill in
the art to vary many parameters in order to achieve the polar
liquid of the present invention; however to make for an even
greater degree of unpredictability, Mondet goes on to include an
additional aqueous phase in his composition. Mondet states in
paragraph [0094] that the composition contains less than 70% by
weight of an aqueous phase, less than 50% by weight of an aqueous
phase, and less than 20% by weight of an aqueous phase. The
aqueous phase may include one or more hydrophilic solvents.
Given the water content of the fatty phase and the aqueous phase
teachings of Mondet, there is absolutely no predictable or

reasonable expectation that a person of ordinary skill in the art could arrive at the specific polar liquid proportion of independent claim 24. In addition since Mondet's phyllosilicate may replace the emulsifier and/or no emulsifier may be used there is also absolutely no predictable or reasonable expectation that a person of ordinary skill in the art could arrive at the specific limitation of the PEG/PPG dimethicone component as claimed. Mondet's teaching of hundreds of components in thousands of combinations would never lead a person of ordinary skill in the art to the specific components of independent claim 24 in the specifically claimed proportions.

An obviousness determination requires that a skilled artisan would have perceived a reasonable expectation of success. See *In re O'Farrell*, 853 F.2d 894, 903-4 (Fed. Cir. 1988). A person of ordinary skill in the art would in no way be predictably lead by the teachings of Mondet to the composition as currently claimed. One of ordinary skill in the art would have to vary all parameters especially Mondet's water content/aqueous phase and emulsifier, go against the teachings of Mondet by not including the phyllosilicate, and/or try each of numerous possible choices until possibly arriving at a successful result, that is, achieving Applicants' claimed subject matter. Applicants contend that predictable modification of Mondet would not lead a person of ordinary skill in the art to the cosmetic preparation as currently claimed.

In determining the differences between the prior art and the claims, the question under 35 U.S.C. 103 is not whether the differences themselves would have been obvious, but whether the claimed invention as a whole would have been obvious. *Schenck v. Nortron Corp.*, 713 F.2d 782, 218 USPQ 698 (Fed. Cir. 1983). When Mondet is properly taken as whole it is apparent that there is no suggestion or teaching in Mondet that would predictably lead a person of ordinary skill in the art to the present invention as claimed; because, Mondet would lead a person of ordinary skill in

the art to a reduced filler composition with vastly varying components and a specific exfoliated phyllosilicate derived from at least one intercalated phyllosilicate. Since Mondet solves the problems associated with excessive fillers by substituting exfoliated intercalated phyllosilicates for the fillers, Mondet teaches away from the non-exfoliated intercalated phyllosilicate preparation of the present invention. As a result, a person of ordinary skill in the art would not be predictably led to the preparation as claimed in independent claim 24.

Applicants contend that the Examiner's conclusion of obviousness over Mondet is based on improper hindsight reasoning gleaned from the Applicants disclosure. The Mondet reference has not been taken as a whole. The proposed modification of Mondet would render Mondet unsatisfactory for its intended purpose. One skilled in the art would not be predictably lead to the current invention as claimed through modification of Mondet. When Mondet is properly taken as whole it is apparent that there is no suggestion or teaching in Mondet that would predictably lead a person of ordinary skill in the art to the present invention as claimed; because, Mondet would lead a person of ordinary skill in the art to a reduced filler composition with vastly varying components and a specific exfoliated phyllosilicate derived from at least one intercalated phyllosilicate. There is no reasonable expectation of success in the modification of Mondet.

In light of the forgoing, it is believed that claims 24-27, 29-42 and 44 are patentably distinct from the art on record and an early indication of the same is respectfully requested.

Applicant submits that independent claim 24, and dependent claims 25-27, 29-42 and 44 are patentably distinct from the art of record and are in condition for allowance.

B. Claim 28 is rejected under 35 U.S.C. §103(a) as being unpatentable over U.S. Pat. Publ. No. 2004/0223990 to Mondet et

al. ("Mondet") as evidenced by Carbopol 1342 product specification sheet and Dow Corning 3225C Formulation Aid specification sheet further in view of U.S. Pat. Publ. No. 2003/0095936 to Orrea et al. ("Light"). Applicants traverse the rejection.

Please see argument below for rejections B-D.

C. Claim 43 is rejected under 35 U.S.C. §103(a) as being unpatentable over U.S. Pat. Publ. No. 2004/0223990 to Mondet et al. ("Mondet") as evidenced by Carbopol 1342 product specification sheet and Dow Corning 3225C Formulation Aid specification sheet further in view of U.S. Pat. Publ. No. 2004/0213747 to Patil et al. ("Patil"). Applicants traverse the rejection.

D. Claim 45 is rejected under 35 U.S.C. §103(a) as being unpatentable over U.S. Pat. Publ. No. 2004/0223990 to Mondet et al. ("Mondet") as evidenced by Carbopol 1342 product specification sheet and Dow Corning 3225C Formulation Aid specification sheet further in view of U.S. Pat. No. 6,509,009 to Nichols et al. ("Nichols"). Applicants traverse the rejection.

Argument for rejections B-D.

As presented above, when Mondet is properly taken as whole it is apparent that there is no suggestion, teaching or motivation in Mondet that would predictably lead a person of ordinary skill in the art to the present invention as claimed; because, Mondet would lead a person of ordinary skill in the art to a reduced filler composition with vastly varying components and a specific exfoliated phyllosilicate derived from at least one intercalated phyllosilicate. Since Mondet solves the problems associated with excessive fillers by substituting exfoliated intercalated phyllosilicates for the fillers, Mondet teaches away from the non exfoliated intercalated phyllosilicate

preparation of the present invention. As a result, a person of ordinary skill in the art would not be predictably led to the preparation as claimed in independent claim 24. Light's teaching of a lip gloss composition, Patil's teaching of a thixotropic agent and Nichols' teaching of a flavoring do not alleviate any of the deficiencies noted above in Mondet. As a result, there is no suggestion, motivation or reasonable expectation of success in the use of Light, Patil, or Nichols in conjunction with Mondet in order to reject the specific limitations of dependent claims 28, 43 and 45, which depend directly or indirectly from independent claim 24.

In light of the forgoing, it is believed that claims 28, 43 and 45 are patentably distinct from the art on record and an early indication of the same is respectfully requested.

Applicant submits that dependent claims 28, 43, and 45 are patentably distinct from the art of record and is in condition for allowance.

CONCLUSION

In light of the foregoing, it is submitted that all of the claims as pending patentably define over the art of record and an early indication of same is respectfully requested.

An earnest and thorough attempt has been made by the undersigned to resolve the outstanding issues in this case and place same in condition for allowance. If the Examiner has any questions or feels that a telephone or personal interview would be helpful in resolving any outstanding issues, which remain in this application after consideration of this amendment, the Examiner is courteously invited to telephone the undersigned and the same would be gratefully appreciated.

It is submitted that the claims as amended herein patentably define over the art relied on by the Examiner and early allowance of same is courteously solicited.

If any fees are required in connection with this case, it is

respectfully requested that they be charged to Deposit Account
02-0184.

Respectfully submitted,

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